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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/605,818	06/28/2000	Jay S. Walker	00-001	5370

22927 7590 07/16/2003

WALKER DIGITAL
FIVE HIGH RIDGE PARK
STAMFORD, CT 06905

EXAMINER

FADOK, MARK A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/605,818

Applicant(s)

WALKER ET AL.

Examiner

Mark A Fadok

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-76 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,8,9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-32 and 51-63 are rejected under 35 USC 101 because these claims have no connection to the technological arts (i.e. computer, network, data processing, internet, ect.). To overcome this rejection, the examiner recommends that the applicant amend the claims to incorporate limitations directed to the technological arts in the body of the claims. Please note that merely reciting technological limitations in the preamble of the claim is not sufficient to overcome this rejection.

Claims 1-76 are rejected under 35 USC 101 because the claimed processes do not achieve a practical application. In this case the final step of "equating" the process outputs to the values of the last set of process inputs found to constitute storing the results of calculations (In re Gelnovatch), furthermore the step of transmitting the results of its calculations, does not constitute the type of post solution activity found in Flook (see MPEP 2106 (i) Safe Harbors).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 1-32 and 51-63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the independent claims the customer appears to have purchased a product and is going to perform a redemption at a third party. The claim later goes on to claim that there is another acceptance of an offer. It is not clear who is receiving information, who is sending information and who is determining to accept an offer. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle (6,512,570) in view of Official Notice.

In regards to claims 1-76, Garfinkle teaches all the limitations of the instant claims except as follows:

Garfinkle transfers information over the Internet, but does not mention receiving the specific information limitations as detailed in the instant claims. It is old and well known in the art that many types of information may be transferred over the Internet to

assure transactions are fulfilled. It would be obvious to a person of ordinary skill in the art to include in Garfinkle receiving the specific information limitations as detailed in the instant claims, because information is critical to making sound decisions and assuring transactions are fulfilled properly, timely and optimally.

Garfinkle teaches determining an offer price, but does not specifically teach calculating a difference between an offer price and a retail price, or accepting an offer if the difference is less than a threshold amount. It is old and well known in the art to calculate a difference between a retail price and an offer price and later determining if the difference is less than a threshold amount. Take for instance a car salesperson that is informed not to sell a car below a certain price (threshold) and calculates the amount of the offer against the sticker price to determine what percentage is being deducted. This would also be done for in store discounts. It would be obvious to a person of ordinary skill in the art to include in Garfinkle calculating a difference between an offer price and a retail price, or accepting an offer if the difference is less than a threshold amount, because when ever a discount is accepted or offered below a retail price it is important to assure it not below a threshold amount to assure that money is not being lost on the transaction.

Garfinkle also teaches evaluating a predetermined set of rules to establish a selected retailer, but does not specifically mention comparing a present market share to a target market share. It is old and well known in the art to compare current market conditions to target conditions to arrive a selected retailer. It would have been obvious to a person of ordinary skill in the art to include in Garfinkle the comparison techniques

as stated in the instant claims to arrive at a determination, because this would allow the central controller to establish which retailer will receive the sale and offer criteria rather than just randomly selecting a retailer.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-4252**. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(703) 308-1344**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

(703) 305-7687 [Official communications; including
After Final communications labeled
"Box AF"]

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(703) 746-7206 [Informal/Draft communications, labeled

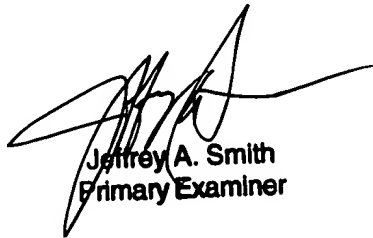
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.



Mark Fadok

Patent Examiner



Jeffrey A. Smith
Primary Examiner